

REMARKS

In response to the Office Action mailed June 10, 2004, Applicants amend their application and request reconsideration in view of the amendments and the following remarks. In this amendment, Claim 1 has been amended and Claim 3 has been cancelled without prejudice. No claims have been added so that Claims 1 and 2 are currently pending. No new matter has been introduced.

The disclosure was objected to for a minor informality that has been corrected by this response.

Claims 1-3 were rejected under 35 U.S.C. § 112, second paragraph. Applicants have amended to the claims to more clearly set forth the invention. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Claims 1-3 were rejected as being unpatentable over U.S. Patent No. 5,876,367 to Kaganov et al. (Kaganov) in view of either U.S. Patent No. 4,230,119 to Blum (Blum) on U.S. Patent No. 3,889,685 to Miller et al. (Miller). This rejection is respectfully requested.

The MPEP, in section 706.02(j), sets forth the basic criteria that must be met in order to establish a *prima facie* case of obviousness.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. In re Vaeck, 947 F.2d,488,20 USPQ2d 1438 (Fed.Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.”

Section 2143.03 of the MPEP clarifies certain criteria in section 706.02(j).

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1074). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)."

None of the references, whether taken alone or in combination disclose a filter system for carotid endarterectomy comprising the elements set forth in amended Claim 1. Specifically, none of the references discloses or suggests a filter membrane having holes with fibers attached in the manner Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

A favorable action on the merits is earnestly solicited.

Respectfully submitted,

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Dated: January 18, 2005

Amendments to the Drawings:

The attached sheet of drawings include changes to Figure 11. This sheet, which includes Figures 11 and 12, replaces the original sheet including Figures 11 and 12. In Figure 11, one element 390 has been corrected to reference numeral 490.

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JAN 21 2005
PATENT & TRADEMARK OFFICE

TITLE: VASCULAR FILTER SYSTEM FOR ...
INVENTOR(S): Gregg S. Sutton, et al.
APP#:
ATTY: C. Evans TEL. #: 732-524-2518
DOCKET #: CRD-0992 CUST. #: 000027777

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